

## **REMARKS**

Claims 1-22 are now pending in this application. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following remarks.

### **CLAIM REJECTIONS--35 U.S.C. 112, FIRST PARAGRAPH**

Examiner rejected Claim 1-20, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner stated that

The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites a 'substantially water-intolerant coating' and there is no support for this requirement in the specification.

(paper 3 at 2)

With respect to the above statement, the Examiner is reminded of the sentence "The edible coating may be dark chocolate, milk chocolate, white chocolate, caramel, confectionary coating, or some other similar coating," (Page 11, lines 2 and 3). As one of ordinary skill in the art would know, dark chocolate, milk chocolate, white chocolate, caramel, and confectionary coating, are substantially water-intolerant. In addition, Cone discloses "a strawberry dressed in a confectionary coating" (Column 2, lines 35 -36). In making the 35 U.S.C. § 103(a) rejection, the Examiner states that Cone teaches of coating fruit with a "substantially water-intolerant coating," (paper 3 at 3). Therefore, by the Examiner's own admission, confectionary coating is considered a substantially water-intolerant coating and Applicant respectfully requests that Examiner

withdraw the rejection of Claims 1-20 based on § 112, first paragraph.

CLAIM REJECTIONS--35 U.S.C. 103

Examiner rejected Claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi, Food Package. and Shigeo, JP 55034966, in view of Cone, U.S. Patent 5,229,149; Waters, U.S. Patent 6,376,000, Macpherson; U.S. Patent 5, 017,394; and Stewart, U.S. Patent 6,616,958. This rejection is respectfully traversed because the film used in Nakanishi is to be used on water-soluble foodstuffs. (See translation, page 17). In the Office Action, Examiner stated the following:

Nakanishi discloses a method of decorating fruit with a design, comprising of selecting a fruit, selecting a design, printing the design, and attaching the design to the fruit (translation, page 17), as further evidenced by Shigeo (translation, page 2).

(Paper 1 at 3); and

It is conventional in the art to provide coated fruit as evidenced by Cone (column 4, lines 52) and the applicant's admission of prior art. To modify Nakanishi and print on a conventional coated fruit, rather than a conventional uncoated fruit, would have been an obvious matter of choice.

(Paper 1 at 3).

Neither Nakanishi nor Shigeo in view of Cone provide for attaching a printed design on fruit coated in a water intolerant coating; whereas Applicant's invention does provide for such coating. The methods of Nakanishi, Shigeo, and Cone are different and, therefore, the limitations of Claims 1- 22 cannot be mere design choices in view of Nakanishi, Shigeo, Cone, or combinations thereof. Examiner has not shown any evidence that the method for printing a design on fruit as disclosed in Nakanishi and Shigeo would allow for a design to be printed on coated fruit.

One of ordinary skill in the art at the time of the invention would not have made the design modifications to the methods of Nakanishi, Shigeo, and Cone as alleged by Examiner. Cone teaches of coating the fruit with a confectionary coating. Confectionary coatings are well known in the art to be water intolerant. Nakanishi teaches of affixing film on “foods having water content, or when used in foods with almost no water content (dried fruit, F-D foodstuffs, etc.) (translation, page 17). Similarly, Shigeo teaches of pasting a film on uncoated fruits. Both Nakanishi and Shigeo teach of using a water-soluble film. Such a film would not work on a water intolerant coating. As is well know in the art, to use the water based film disclosed in Nakanishi and Shigeo and the printing methods disclosed in Shigeo with the water-intolerant coating in Cone, as the Examiner has suggested would result in the chocolate seizing and becoming thick, lumpy, grainy, or flakey.

In addition, Waters discloses the use of molds. A mold has a constant shape and planar surfaces. The present invention is used on enrobed fruit which can vary in size and shape in every dimension. Attempting to develop molds for each possible size and shape of fruit would be cost prohibitive. Producing a mold that was larger than any possible fruit would result in a chocolate coating that was too thick to bite through without spoiling the effect of the mix of chocolate and fresh fruit and would be aesthetically unpleasing. Consequently, the molds disclosed in Waters cannot be used on fruit due to the inconsistent shape of fruit. Additionally, the Examiner is respectfully requested to view the attached affidavit submitted under 37 CFR 1.132. The affidavit is being submitted to show that using Waters to achieve inventors’ method is not feasible. Affiant, Paul Manley Jr., has over 7 years of experience in the art and attests that the methods used in Waters could not be used on fruit because Waters discloses molds that have consistent shapes and planar surfaces. Such methods would not work on the inconsistent shape and non-planar surfaces

of fruit.

Essentially, one of ordinary skill in the art would not be inclined to modify Nakanishi to be able to decorate fruit coated with a water-intolerant coating. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Since Nakanishi or Shigeo in view of Cone or Waters have no teaching, suggestion, or motivation for modifying the method of printing an image on uncoated fruit disclosed therein, the rejection lacks proper basis and should be withdrawn.

For the reasons stated above and because Claims 2-18 and 21 - 22 depend from Claim 1 which should now be deemed allowable, Examiner is respectfully requested to withdraw the rejections made to Claims 2-18 under 35 U.S.C. § 103. Also, for the reasons stated above, the rejections made to Claims 19 and 20 should be withdrawn.

Examiner rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Waters, and the admitted prior art in view of Nakanishi and Shigeo. This rejection is respectfully traversed. In the Office Action, Examiner stated the following:

In regards to claim 4, Waters (column 6, line 49) and the applicant's admission of the prior art disclose the use of an inkjet printer for printing designs onto edible sheets. To use this method to print designs for coated fruit would be obvious, in view of Nakanishi and Shigeo, to provide a quick way of printing and designs and an easy way to reproduce designs without changing the consistency of the coating.

Neither Waters, the disclosed prior art, Nakanishi nor Shigeo either alone or in combination disclose Applicant's invention. For the reasons stated above, neither Nakanishi nor Shigeo provide for attaching a printed design on fruit coated in a water intolerant coating. Also, Shigeo teaches away from using an ink jet printer. Shigeo states:

Furthermore, printing in an ink jet method has also been investigated, but despite the fact that expensive printing machines are required in this method, a print image without distortion cannot be obtained.

(Translation, page 3)


One of ordinary skill in the art at the time of the invention would not have been compelled by Shigeo to modify either Waters or the disclosed prior art to create a method for attaching a printed design on fruit coated in a water intolerant coating. Therefore, neither Waters, the disclosed prior art, Nakanishi nor Shigeo are combinable to render obvious Applicants' invention as proffered by Examiner. In view of the above, Applicants respectfully request the Examiner to withdraw the rejection of Claim 4 under 35 U.S.C. § 103.

### **CONCLUSION**

Given the arguments presented above, Applicants submit that Claims 1-22 are now in condition for allowance. Therefore, Applicants respectfully request that Examiner withdraw all rejections to the above-referenced claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Steven B. Leavitt or John Pemberton at (972) 412-2671.

Respectfully submitted,

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I hereby certify that the enclosed Application is being deposited with the United States Postal Service via Express Mail service, as Express Mail No. EO 910374435 in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 17, 2005.

Name: 

Paul F. Manley, Jr.